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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/423,606	11/12/1999	KAZUTAKA HAYASHI	3114-0025-0X	6947

22850 7590 11/14/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

NOLAN, SANDRA M

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 11/14/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/423,606	HAYASHI ET AL.	
	Examiner	Art Unit	
	Sandra M. Nolan	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 August 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,6-21,23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) 7-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,6,23 and 24 is/are rejected.
- 7) ☒ Claim(s) 1 and 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☒ All   b) ☐ Some \* c) ☐ None of:  
 1. ☒ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |                                                                                              |                                                                             |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claims***

1. Claims 1-3, 6-21 and 23-24 are pending. Claims 7-21 are withdrawn as nonelected.

### ***Rejection Withdrawn***

2. The 35 USC 103 rejection of claims 1-3, 5-6 and 22-23 as unpatentable over Hanson et al (US 5,328,975) in view of Morishima et al (US 5,271,768) and Terakawa (US 5,500,455) is withdrawn in order to apply the new ground of rejection below.

### ***New Objections***

3. Claims 1 and 6 are objected to because of the following informalities:  
  
In claim 1, last line, there should be a period [.] not a comma after "different".  
  
In claim 6, line 2, after "or", the Greek symbol " $\gamma$ " is missing.

Appropriate correction is required.

### ***New Rejection***

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 6 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson in view of Morishima and Terakawa for reasons of record.

***Response to Arguments***

5. Applicant's arguments filed in the response dated 20 August 2003 (Paper No. 18) have been fully considered but they are not persuasive.

The arguments in Paper No. 18 will be responded to in the order in which they were presented.

Applicants assert, on page 9 of Paper No. 18, that Hanson teaches compounds of formula (1) in which R can be vinyl. The examiner agrees.

Applicants argue that since Hanson also says that since Hanson's R need not be polymerizable, it does not suggest the importance of a polymerizable group.

However, in the absence of convincing objective evidence to the contrary, one of ordinary skill is free to select any useful R groups for use in Hanson's compounds of formula (1). There is nothing on the record to demonstrate otherwise.

Applicants argue, on page 10, that Hanson does not teach the combination of compounds (1), (2) and (3).

However, Hanson teaches, that the  $R_xSi(OR')_{4-x}$  compound shown in its abstract may be one in which x may be zero and R' is an alkyl group. When these conditions exist, the compound in the abstract meets formula (2). Also, says that mixtures of alkoxy silanes can be used (col. 1, lines 56-57), and teaches the use of titanium alkoxides of applicants' formula (3) (see col. 2, lines 1-8). Thus, Hanson teaches all three of the compounds recited in claim 1.

On page 10, applicants argue that Hanson is coating light bulbs and semiconductors and therefore requires water.

However, the claims do not exclude the use of water from the claimed coating agents. Applicants are arguing a limitation that is not recited in the claims.

On page 10, applicants argue that the Morishima compositions require a catalyst and their compositions do not.

However, the claims do not exclude catalysts. In fact, applicants' claim 3 calls for a "polymerization initiator". It appears that applicants are again arguing a limitation that they are not claiming.

On page 10, applicants argue that their invention used polymerization temperatures that are lower than those of Morishima.

However, the temperature limitations discussed are not before the examiner. There are no process claims now under consideration.

On page 10, applicants argue that Morishima is coating light bulbs and semiconductors and therefore requires water.

However, the claims do not exclude the use of water from the claimed coating agents. Applicants are arguing a limitation that is not recited in the claims.

On page 10, applicants argue that correction fluids, such as those of Terakawa, are not coatings.

However, a material that is applied to paper to coat it, and thereby cover mistakes, is a coating.

On pages 10 and 11, applicants argue that Terakawa's correction fluids cannot produce a glassy film.

However, Terakawa was cited to show the use of dispersants to keep pigments in dispersion, not for the nature of the coatings which employ the pigments and the dispersants. This is a combination rejection under 35 USC 103. It is improper to argue the teachings of one reference to the exclusion of the teachings of the others.

Also, the coatings of Hanson/Morishima can be deemed "glassy" because they are applied to glass substrates. Note applicants' discussion of light bulbs as substrates on page 10 of Paper No. 18.

On page 11, applicants argue that Terakawa requires the absence of water.

However, the claims under consideration do not require water.

On page 11, applicants argue that Terakawa, which requires water is not properly combinable with Hanson and Morishima, which do not.

However, the claims say nothing about the use of water and the Terakawa patent is not being used to show the reactive components of the coating, but merely the use of dispersants to keep fillers dispersed in the coatings until they are used.

Also, Terakawa is cited only to show the use of dispersants to keep pigments in dispersion. Applicants have not shown that the dispersing ability of the Terakawa dispersants would not function to keep pigments dispersed in the coatings of Hanson or Morishima.

It is noted that Hanson teaches pigments in its compositions. See the discussions of titania (col. 3, lines 11-15 and col. 6, lines 31 and 34) and silica (col. 6, line 34) therein.

***Final Rejection***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

7. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Conclusion***

Any inquiry concerning this communication should be directed to Sandra M. Nolan, whose telephone number is 703/308-9545. The Examiner can normally be reached on Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time.

If attempts to reach the Examiner by telephone are unsuccessful, her supervisor, Harold Pyon, can be reached at 703/308-4251. The general fax number for the art unit is 703/872-9306. The receptionist answers 703/308-0661.



S. M. Nolan  
Patent Examiner  
Technology Center 1700

SMN/smn  
09423606(19)  
10 November 2003